

REMARKS/ARGUMENTS

This Reply is being filed in response to the final Official Action of January 4, 2011. The Official Action continues to reject Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0064164 to Barany et al. The Official Action also continues to reject Claims 5, 13, 22, 31, 40 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Barany, in view of U.S. Patent Application Publication No. 2004/0156380 to Silverman et al.; and reject the remaining claims, namely Claims 6, 15, 24, 33, 42 and 51, as being unpatentable over Barany, in view of U.S. Patent Application Publication No. 2005/0210292 to Adams et al.

As explained below, Applicant again respectfully submits that the claimed invention is patentably distinct from Barany, Silverman and Adams, taken individually or in any proper combination. In view of the remarks presented herein, Applicant respectfully requests reconsideration of the present application and allowance of the pending set of claims. Alternatively, Applicant respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal as the remarks presented herein do not raise any new issues or introduce any new matter.

A. Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 are Patentable

The final Official Action rejects Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 as being anticipated by Barany. Before addressing the rejection, Applicant notes that for a reference to anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (cited in MPEP § 2131). A single cited reference must expressly or inherently disclose each claim limitation. *Finstar Corp. v. DirectTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2003). “But disclosure of each element is not quite enough... ‘[a]nticipation requires the presence in a single prior art disclosure of all the elements of the claimed invention arranged as in the claim.’” *Id.* (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548) (emphasis added). Further, the Federal Circuit has reversed lower courts when those lower courts have “treated the claims as mere catalogs of separate parts, in disregard to the part-to-part

relationships set forth in the claims that give the claims their meaning.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984).

The following sections present Applicant’s previous arguments distinguishing the claimed invention from Barany, and addresses the Examiner’s responses to those arguments. The final Official Action identifies Applicant’s arguments as raising issues, which the final Official Action has numbered. For purposes of review, Applicant reiterates and follows the numbering of their arguments below.

1. Claims 1-9, 19-27 and 37-45 are Patentable over Barany

Relative to independent Claim 1 (and similarly independent Claims 19 and 37), Applicant again presumes the Official Action alleges the following correspondence between independent Claim 1 and Barany, citing FIGS. 1 and 3, and paragraphs [0023], [0062] and [0063] of Barany.

Claim 1	Barany
An apparatus comprising: a processor; and a memory including computer program code, the memory and computer program code configured to, with the processor, cause the apparatus to at least:	Call state control function (CSCF) module 40
receive a connection request via a network across which an originating client is configured to communicate;	[0023] ... In some embodiments, the CSCF module 40 is a (Session Initiation Protocol) SIP proxy or server that receives call requests on behalf of other entities, resolves logical addresses or identifiers in the call requests, and forwards the call requests to intended destinations. ...
prepare a network- independent trigger for transmission to a terminal in response to receipt of the connection request; and	[0063] After SIP registration, the mobile station can initiate a packet-switched call by sending call setup messages (at 108). To initiate a call, the SIP INVITE request is sent, which includes the destination address of the terminal being called and indicates that the called terminal is being invited to participate in a call session. Various acknowledgment messages, as defined by SIP, are also exchanged between the mobile station and the

	CSCF 40. The SIP messages are routed through the CSCF 40 since the CSCF 40 acts as the SIP proxy.
receive a registration message, in response to the trigger, from the terminal via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal.	[0062] After the primary PDP context has been activated, a SIP registration procedure is performed (at 106). The SIP registration procedure is performed with the CSCF 40, which includes the SIP proxy. SIP registration is performed to set up the profile for the mobile station in the CSCF 40, so that the CSCF 40 is aware of the mobile station's existence as well as various configuration information associated with the mobile station.

(a) Network-Independent Trigger

As previously explained, in contrast to independent Claim 1, Barany does not teach or suggest an apparatus being caused to prepare a network-independent trigger for transmission to a terminal in response to receipt of a connection request. The Official Action cites the SIP INVITE of paragraph [0063] of Barany for allegedly disclosing this feature. As identified as issue (1) in the final Official Action, however, Applicant notes that nowhere does Barany disclose that its SIP INVITE is prepared for transmission “in response to receipt of a connection request;” instead, Barany’s SIP INVITE is a connection request. *See* Barany, para. [0063] (“To initiate a call, the SIP INVITE request is sent”). Accordingly, as identified as issue (2), Barany also does not disclose that its SIP INVITE is independent of the network via which a connection request is received, i.e., “network-independent.” Moreover, per issue (3), Barany does not disclose that its SIP INVITE is prepared for transmission to the terminal from which a registration message is received. In Barany, the SIP INVITE is transmitted from the mobile station that registered with the CSCF.

(i) Issue (1)

In response to issue (1), the final Official Action states that by virtue of Barany’s SIP proxy receiving a SIP INVITE (alleged connection request) and forwarding it to an intended destination, the forwarded SIP INVITE constitutes a trigger prepared for transmission in response to receipt of a connection request. In this interpretation, the Examiner appears to

consider the SIP INVITE to constitute both the recited connection request and trigger. Even given this interpretation, however, and now turning to issue (2), Barany still does not disclose that its SIP proxy receives the SIP INVITE (alleged connection request) via a network, but forwards the SIP INVITE (alleged trigger) independent of the network, similar to the trigger of independent Claim 1.

(ii) Issue (2)

In response to issue (2), the final Official Action states that “according to fig. 5 of the present application, the Examiner understands the network independent trigger as a communication initiation between the SIP proxy and the terminating node or client as the result of forwarding a requested call, which is clearly disclosed by Barany.” Official Action of Jan. 4, 2011, p. 3. Initially, as to the example embodiment illustrated by FIG. 5, Applicant notes that the network-independent trigger is not the result of the SIP proxy forwarding a requested call, but is instead in response to the SIP proxy receiving an INVITE message. The SIP proxy does not forward the INVITE message to the terminating SIP client until later in the process after the terminating SIP client has registered with the SIP proxy.

Further, Applicant submits that the network-independent trigger is more than simply a communication between SIP proxy and terminating node or client, as suggested in the Official Action. Rather, the network-independent trigger is “network independent.” That is, the network-independent trigger is a communication independent of the network via which the connection request is received. Applicant submits that any interpretation of the trigger of independent Claim 1 that does not consider that the trigger is explicitly recited as being “network-independent” impermissibly fails to give all words in the claim their normal meaning, as required. *See Ex parte Maurice Givens*, Appeal No. 2009-003414, Application No. 11/265,973 (BPAI Aug. 6, 2009) (holding that an interpretation of a claim that fails to give weight to words in a claim deprives the respective words of their normal meaning).

(iii) Issue (3)

In response to issue (3), the Official Action states:

[I]f the SIP proxy receives call requests on behalf of other entities and forwards said call requests to intended destinations; that is, connecting an originating communication device, e.g., the call requestor, with a termination device, e.g., the intended call destination, it is evident that the response to the requested call replaces the SIP INVITE sent from the SIP proxy to the destination node or client and is prepared for transmission to the terminal from which a registration message is received.

Official Action of Jan. 4, 2011, p. 3. Applicant submits that even if one could argue that the response to a SIP INVITE is prepared for transmission to the terminal from which a registration message is received (the registered terminal having originally sent the SIP INVITE message), the response is not being cited as corresponding to the recited trigger. Instead, the Official Action cites the SIP INVITE message itself as the recited network independent trigger. And to now cite a response message as the trigger, the Official Action is impermissibly treating the claims as a mere catalog of separate parts, and disregards the part-to-part relationships set forth in the claims.

For at least the foregoing reasons, Applicant reiterates that the SIP INVITE of Barany does not correspond to a trigger similar to that of independent Claim 1.

(b) Registration Message - Issue (4)

As also previously explained and as identified as issue (4), in further contrast to independent Claim 1, Barany does not teach or suggest an apparatus being caused to receive a registration message, in response to the network-independent trigger, via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal. The Official Action cites the SIP registration procedure of paragraph [0062] of Barany for allegedly disclosing this feature. However, Applicant notes that nowhere does Barany disclose that its SIP registration procedure occurs or that any registration message is received in response to the SIP INVITE – similar to the recited receipt of a registration message “in response to the network-independent trigger.” In fact, Barany explicitly discloses that SIP registration occurs before (not in response to) its SIP INVITE (alleged trigger) is sent. See Barany, para. [0063]

("After SIP registration, the mobile station can initiate a ... call To initiate a call, the SIP INVITE request is sent").

In response to issue (4), the Official Action appears to misunderstand Applicant's argument. The Official Action asserts that it is well known for that registration has to take place to establish communication between telecommunication devices, and further asserts that Barany clearly discloses SIP registration. Applicant agrees that Barany discloses SIP registration. But instead of Barany disclosing receipt of a registration message in response to a SIP INVITE (alleged trigger), Barany discloses receipt of a registration message (or rather, SIP registration) before the SIP INVITE. According to independent Claim 1, on the other hand, the registration message is received in response to the trigger (alleged SIP INVITE), and not vice versa.

2. *Claims 10-18, 28-36 and 46-54 are Patentable over Barany*

Relative to independent Claim 10 (and similarly independent Claims 28 and 46), Applicant again presumes the Official Action alleges the following correspondence between independent Claim 1 and Barany, citing FIGS. 1 and 3, and paragraphs [0023], [0062] and [0063] of Barany.

Claim 10	Barany (annotated per the Official Action)
An apparatus comprising: a processor; and a memory including computer program code, the memory and computer program code configured to, with the processor, cause the apparatus to at least:	Call state control function (CSCF) module 40
receive a registration message via a network across which an originating client is configured to communicate, wherein the apparatus being caused to receive a registration message comprises the apparatus being caused to receive a registration message from a terminal to thereby register the terminal with the apparatus, and	[0062] After the primary PDP context has been activated, a SIP registration procedure is performed (at 106). The SIP registration procedure is performed with the CSCF 40, which includes the SIP proxy. SIP registration is performed to set up the profile for the mobile station in the CSCF 40, so that the CSCF 40 is aware of the mobile station's existence as well as various configuration information associated

	with the mobile station.
wherein the registration message includes a network-independent identity of the terminal; and	“[A] SIP proxy ... registers the calling and called parties, handling the IP addresses required for packet switched communication; these IP address [sic] are independent of the circuit-switched cellular network, on behave [sic] of which the CSCF SIP proxy receives and handles those packet-switched call requests.” Official Action of Oct. 7, 2010, pp. 6-7.
prepare a network-independent trigger for transmission to the terminal based upon the network-independent identity of the terminal to thereby trigger the terminal to update registration of the terminal with the apparatus, including acquisition by the apparatus of a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal.	[0063] After SIP registration, the mobile station can initiate a packet-switched call by sending call setup messages (at 108). To initiate a call, the SIP INVITE request is sent, which includes the destination address of the terminal being called and indicates that the called terminal is being invited to participate in a call session. Various acknowledgment messages, as defined by SIP, are also exchanged between the mobile station and the CSCF 40. The SIP messages are routed through the CSCF 40 since the CSCF 40 acts as the SIP proxy.

As previously explained and as identified as issue (5), in contrast to independent Claim 10, Barany does not teach or suggest an apparatus being caused to at least prepare a network-independent trigger for transmission to a terminal based upon a network-independent identity of the terminal to thereby trigger the terminal to update its registration with the apparatus, including acquisition by the apparatus of a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal. The Official Action cites the SIP INVITE of paragraph [0063] of Barany for allegedly disclosing this feature; and for other features of independent Claim 10, cites GSM as the received network via which a registration message is received, and cites an IP address of a mobile station as the recited network-independent identity.

In contrast to the assertions in the Official Action, and as identified as issue (6), Applicant notes that nowhere does Barany disclose that the SIP INVITE is independent of the

network (alleged GSM) via which the registration message is received, i.e., “network-independent.” Barany also does not disclose that its SIP INVITE is prepared for transmission to the terminal from which a registration message is received. In Barany, the SIP INVITE is transmitted from the mobile station that registered with the CSCF. Further, nowhere does Barany disclose that its SIP INVITE triggers the mobile station “to update registration” of the mobile station (alleged terminal) with the CSCF (alleged apparatus). Other than disclosing that the SIP INVITE is sent after SIP registration, nowhere does Barany disclose that its SIP INVITE has any affect on SIP registration. Moreover, nowhere does Barany disclose acquisition of a GSM-dependent identity (network-dependent identity, GSM being the alleged network) of the mobile station to enable establishment of a communication session with the mobile station based on the GSM-dependent identity (network-dependent identity), similar to independent Claim 10.

(iii) Issue (5)

In response to issue (5), the Official Action states that “since the SIP proxy receives call requests on behalf of other entities and forwards said call requests to intended destinations (see [0023]), there is no way to communicate with an intended destination without an identity of the destination node or device.” Official Action of Jan. 4, 2011, p. 4. Applicant fails to see how the fact that communication with a destination requires its identity has any pertinence to whether Barany anticipates the claimed invention. As explained above, independent Claim 1 recites preparation of a network-independent trigger for transmission to a terminal based on a network-independent identity of the terminal, which triggers the terminal to update its registration including acquisition of a network-dependent identity of the terminal. Even if Barany does communicate with an intended destination based on its identity, nowhere does Barany disclose that its SIP INVITE (alleged trigger) is network-independent and prepared for transmission based on a network-independent identity. And further, nowhere does Barany disclose that its SIP INVITE triggers a registration update including acquisition of a network-dependent identity.

(iv) Issue (6)

Regarding issue (6), the Official Action reiterates its interpretation of the network-

independent trigger as in issue (2). But as explained above, not only is this interpretation incorrect, it fails to give all words in the claim their normal meaning. That is, the network-independent trigger is not the result of the SIP proxy forwarding a requested call, but is instead in response to the SIP proxy receiving an INVITE message. And any interpretation of the recited trigger that ignores the explicit recitation of the trigger being network-independent impermissibly fails to give all words in the claim their normal meaning, as required.

Applicant therefore respectfully submits that independent Claim 1, and by dependency Claims 2-9, is patentably distinct from Barany. Applicant also respectfully submit that independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of independent Claim 1, including the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be established. As such, Applicant also respectfully submits that independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany for at least the same reasons given above with respect to independent Claim 1.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39, 43-48 and 52-54 as being anticipated by Barany is overcome.

B. Claims 5, 13, 22, 31, 40 and 49 are Patentable

The Official Action rejects Claims 5, 13, 22, 31, 40 and 49 as being unpatentable over Barany, in view of Silverman. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany. Applicant respectfully submits that Silverman does not cure the deficiencies of Barany. That is, even considering Silverman, neither Barany nor Silverman, taken individually or in any proper combination, teaches or suggests the aforementioned terminal-triggering feature, as recited by the claimed invention. And there is no apparent reason for one skilled in the art still to modify Barany with the teachings of Silverman in an effort to obviate the claimed invention. Thus, for at least the foregoing reasons as well as those given above with respect to independent

Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Barany, in view of Silverman.

Applicant accordingly submit that the rejection of Claims 5, 13, 22, 31, 40 and 49 as being unpatentable over Barany, in view of Silverman is overcome. **C. Claims 6, 15, 24, 33, 42 and 51 are Patentable**

The Official Action rejects Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Barany, in view of Adams. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Barany. Applicant respectfully submits that Adams does not cure the deficiencies of Barany. That is, even considering Adams, neither Barany nor Adams, taken individually or in any proper combination, teaches or suggests the aforementioned terminal-triggering feature, as recited by the claimed invention. And there is no apparent reason for one skilled in the art still to modify Barany with the teachings of Adams in an effort to obviate the claimed invention. Thus, for at least the foregoing reasons as well as those given above with respect to independent Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Barany, in view of Adams.

Applicant accordingly submit that the rejection of Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Barany, in view of Adams is overcome.

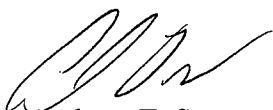
Application No.: 10/797,765
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Reply to Official Action of January 4, 2011

CONCLUSION

In view of the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues. As explained above, no new matter or issues are raised by this Reply, and as such, Applicant alternatively respectfully request entry of this Reply for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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